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26517 7590 09/09/2010 WOOD, HERRON & EVANS, L.L.P. (IBM) 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* ERIC LAWRENCE BARSNESS and
9 JOHN MATTHEW SANTOSUOSSO
10

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12 Appeal 2009-009192
13 Application 09/921,332
14 Technology Center 3600
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18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH
19 A. FISCHETTI, *Administrative Patent Judges*.
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Eric Lawrence Barsness and John Matthew Santosuosso (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-31, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION²

We AFFIRM.

THE INVENTION

The Appellants invented a method for computer-assisted advertising and marketing. Specification 1:10-11.

An understanding of the invention can be derived from a reading of exemplary claims 1, 8, 14, and 15, which are reproduced below [bracketed matter and some paragraphing added].

1. A computer-implemented method of advertising, comprising:

(a) searching a plurality of electronic messages associated with at least one electronic community to locate a first electronic message including a query directed to a topic of interest; and

(b) subsequent to locating the first electronic message, sending a second electronic message including a reply to the query and

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 20, 2006) and the Examiner's Answer ("Ans.," mailed February 9, 2007), and Final Rejection ("Final Rej.," mailed June 16, 2006).

1 an advertisement related to the topic of interest to which the
2 query is directed.

3
4 8. The method of claim 1, wherein the reply includes an answer
5 to the query.

6
7 14. The method of claim 1, further comprising determining
8 whether the query is capable of being answered, wherein
9 sending the second electronic message is performed if it is
10 determined that the query is capable of being answered.

11
12 15. The method of claim 1, further comprising determining
13 whether the query has already been answered, wherein sending
14 the second electronic message is performed if it is determined
15 that the query has not yet been answered.

16
17 THE REJECTIONS

18 The Examiner relies upon the following prior art:

Messina et al. US 2004/0172415 A1 Sep. 2, 2004

19
20 Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable
21 over Messina and Admitted Prior Art.

22
23 ISSUES

24 The issue of whether the Examiner erred in rejecting 1-31 under 35
25 U.S.C. § 103(a) as unpatentable over Messina and Admitted Prior Art turns
26 on whether Messina and the Admitted Prior Art describe replying to a query,

whether there is a motivation to modify Messina to include the Admitted
Prior Art, and whether such a combination requires impermissible hindsight.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be
supported by a preponderance of the evidence.

Facts Related to Appellants' Disclosure

01. There are various known search engine algorithms that
determine best fit matches to a particular query and answer based
upon keyword comparisons. Specification 17:17-19.

Facts Related to the Prior Art

Messina

02. Messina is directed to systems, methods, and software for
automating the posting and retrieval of content from multiple data
services, such as newsgroups, message boards, forums, as well as
encouraging active participation and growth of on-line
communities. Messina ¶ 0008. Messina is specifically concerned
with searching for and collecting relevant information. Messina
¶'s 0005-0006.

03. Messina describes a method that begins by determining a theme
or topic for a database by storing one or more keywords, concepts,
or other attributes in the fitness and/or theme data. Messina ¶'s
0067-0068. Subsequently, sets of candidate members, which
include websites or portions of websites, are identified, evaluated,

1 and ranked based on research citations, research numbers, quality
2 of research papers, and the number and quality of posts as they are
3 related to the fitness or theme data. Messina ¶'s 0070-0071. The
4 identification of candidate members can be done with the use of a
5 crawler module that has the capability to parse metadata to
6 determine the fitness of the content. Messina ¶ 0072. After
7 candidate members are identified, expert, contributor, or
8 community candidates are recruited or invited to join the website.
9 Messina ¶ 0074. The crawler module posts messages
10 encouraging participants of newsgroups, message boards, etc.,
11 from which it retrieves content to visit or request information
12 about one or more of its affiliated websites. Messina ¶ 0075. The
13 messages can include hyperlinks or URLs to the site and an
14 incentive to visiting the website. Messina ¶ 0075. Based on the
15 content of a candidate member's post, a reply directly to that post
16 can include information, such as websites, on-line forums,
17 newsgroups, etc., with which the candidate member would be
18 interested in. Messina ¶ 0075.

19 *Facts Related To The Level Of Skill In The Art*

20 04. Neither the Examiner nor the Appellants have addressed the
21 level of ordinary skill in the pertinent arts of electronic marketing
22 and advertising systems. We will therefore consider the cited prior
23 art as representative of the level of ordinary skill in the art. *See*
24 *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001)
25 ("[T]he absence of specific findings on the level of skill in the art
26 does not give rise to reversible error 'where the prior art itself

reflects an appropriate level and a need for testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

05. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

ANALYSIS

Claims 1-31 rejected under 35 U.S.C. § 103(a) as unpatentable over Messina and Admitted Prior Art

The Appellants first contend that (1) Messina and the Admitted Prior Art fail to describe limitations (a) and (b) of claim 1. App. Br. 5. The Appellants specifically argue that Messina fails to describe the second message include a specific reply to the *query* along with an advertisement related to the topic of interest of the *query*. App. Br. 6. We disagree with the Appellants. Limitation (a) requires searching an electronic community’s messages for a message with a query. Limitation (b) further requires sending a reply message to the query with an advertisement related to the topic of the query.

Messina describes a method that searches Internet message boards using a crawler module for content that matches the predetermined content themes and determines the fitness of that data. FF 03. That is, a crawler reads the content on message boards for messages that contain content that is related to the pre-determined theme or fitness criteria. Messina further describes

1 replying to specific messages by users with websites, on-line forums,
2 newsgroups, and other information related to the topic of the message posted
3 by a user. FF 03. As such, Messina describes all of the limitations of claim
4 1 except that Messina fail to describe that the content of the message
5 includes a query.

6 The Appellants admit in the specification that search engine algorithms
7 that determine best fit matches to a particular query and answer that are
8 based upon keyword comparisons are known. FF 01. That is, determining
9 whether a message contains a query is well-known in the art. The
10 Appellants specifically argue that a reply to a *query* is distinguished from a
11 reply to a *message* (App. Br. 6 and 10); however, the Appellants fail to
12 provide any specific rationale that highlights the differences between
13 replying to a message as opposed to replying to a query. Regardless, the
14 Admitted Prior Art describes detecting a query and the Appellants fail to
15 provide any further rationale distinguishing the claimed invention from the
16 prior art. As such, the combination of Messina and the Admitted Prior Art
17 describes all of the features of limitations (a) and (b) of claim 1. The
18 Appellants reiterate this argument in support of claims 8, 14-15, 23, and 28-
19 29 (App. Br. 10-13); however, this argument is not found persuasive for
20 claims 8, 14-15, 23, and 28-29 for these same reasons discussed *supra*.

21 The Appellants additionally contend that (2) the Examiner has relied on
22 impermissible hindsight since the Examiner used the Appellants' disclosure
23 in constructing the rejection and there is no motivation to modify Messina in
24 the manner proposed by the Examiner. App. Br. 6-7. The Appellants
25 reiterate this argument in support of claims 14-15 and 28-29. App. Br. 12-
26 13. We disagree with the Appellants. Messina is concerned with the ability

1 to search for relevant information and provide related information. FF 02.
2 Messina solves this problem by describing a method that searches through
3 the Internet for messages with specific content, defined by the user as theme
4 or fitness data, and providing related information based on that specific
5 content. FF 03. The Appellants admit that the ability to use search engines
6 to search messages for queries and answers is known. FF 01. A method that
7 includes such a feature increases the accuracy and utility of the method by
8 providing users with information directly related to their message or query.
9 Since this information was known in the art at the time of the invention, a
10 person with ordinary skill in the art would have recognized to modifying
11 Messina's theme or fitness data to require queries or messages that include
12 questions and such a modification would have yielded predictable results.
13 Therefore, a person with ordinary skill in the art would have been led to
14 modify Messina, at the time of the claimed invention, in order to increase the
15 accuracy and utility of providing replies to messages. As such, this
16 information and motivation were available to persons with ordinary skill in
17 the art at the time of the claimed invention.

18 The Appellants also contend that (3) Messina fails to describe "an
19 answer to the query" as required by claims 8 and 23. App. Br. 10-11. The
20 Examiner found that a reply to a query is inherently an answer to that query
21 (Ans. 6); however, the Appellants further argue that an "answer" is
22 distinguished from a "reply" and therefore the Examiner's rationale is
23 incorrect. App. Br. 10-11. We disagree with the Appellants. The
24 Appellants point to two portions of the specification that describes two
25 different embodiments of an answer. App. Br. 10. However, the
26 specification explicitly states that these embodiments are only provided as

1 examples without the intention to limit the scope of the invention.
2 Specification 5:19-21. Since these embodiments of the term “answer” are
3 only examples, the term “answer” is not specially defined in the
4 specification and the claims do not further limit the scope of an answer.
5 Therefore, the Appellants are merely arguing limitations that are not
6 required by the claims. Furthermore, the construction of an “answer” by the
7 Examiner is reasonable since an answer can reasonable be any response to a
8 question or query. As such, the Appellants’ argument is not found
9 persuasive.

10 The Appellants further contend (4) Messina and the Admitted Prior Art
11 fail to describe determining whether a query is capable of being answered,
12 such that the second message is sent only if it is determined that the query is
13 capable of being answered, as per claims 14 and 28. App. Br. 11-12. We
14 disagree with the Appellants. Messina specifically describes that message
15 boards are searched for theme and fitness data that is based on keywords or
16 concepts. FF 03. These replies to the messages are based on the searched
17 keywords and concepts. FF 03. That is, if a message does not contain data
18 on a topic or concept that is being searched for, that message is not
19 responded to. Since the Admitted Prior Art includes the concept of
20 searching for queries and providing answer (FF 01), the combination of
21 Messina and the Admitted Prior Art describe searching for messages that
22 include queries on specific topics and responding to those specific. As such,
23 Messina and the Admitted Prior Art describe the limitations of claims 14 and
24 28.

25 The Appellants further contend that (5) Messina fails to describe or
26 suggest determining whether the query has already been answered, wherein

1 sending the second electronic message is performed if it is determined that
2 the query has not yet been answered. App. Br. 13. We disagree with the
3 Appellants. As discussed *supra*, Messina describes the reading of the
4 content of messages for keywords and concepts. A person with ordinary
5 skill in the art would have recognized to include the concept of not
6 answering a message or query that has already been answered. The
7 modification of Messina to include this feature would only require minor
8 adjustments to the key concepts of searching messages and would be done
9 so as to not appear impersonal and computerized. As such, a person with
10 ordinary skill in the art would have recognized to modify Messina to include
11 such a feature in order to maintain an appearance that the replies are not
12 impersonal or computer and such a modification can be done with
13 predictable results.

14 15 CONCLUSIONS OF LAW

16 The Examiner did not err in rejecting claims 1-31 under 35 U.S.C.
17 § 103(a) as unpatentable over Messina and Admitted Prior Art.

18 DECISION

19 To summarize, our decision is as follows.

- 20 • The rejection of claims 1-31 under 35 U.S.C. § 103(a) as unpatentable
21 over Messina and Admitted Prior Art is sustained.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
§ 1.136(a)(1)(iv) (2007).

AFFIRMED

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